

**REMARKS**

Claims 6 and 14 are all the claims currently pending in the present Application.

**Claim Objections**

Claims 6 and 14 stand objected to. Applicant amends the claims, as shown for purposes of clarity and respectfully requests that the objections to the claims be reconsidered and withdrawn.

**§112 Rejection**

Claims 6 and 14 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being incomplete for omitting essential elements. Applicant respectfully traverses the rejection.

The Examiner alleges, with respect to claim 6, that while the claim recites processing blocks and each processing block includes a rake combiner, missing “essential elements” include fingers and searcher “required to be used in cooperation with the rake combiners to process the received data in each [claimed] processing block.” The Examiner also alleges that the claim should specify first and second rake combiners in each processing block.

While an embodiment of the invention shown in Figure 8 does show the elements referred to in the Examiner’s rejection, they are not “essential elements” that must be claimed. An element is essential to a claim only if the Applicant has disclosed in the specification or the prosecution record that the element is essential to the invention. See MPEP 2172.01.

A claim particularly points out and distinctly claims the subject matter which an Applicant regards as his invention unless Applicant has otherwise indicated that he intends the claims to be of a different scope. *In re Mayhew*, 188 USPQ 356 (CCPA 1976). Nowhere in the

specification of this Application or in its prosecution history has Applicant indicated that “finger”, “searcher” or “two rake combiners” are essential to the invention.

Applicant submits that a claim does not have to list all the elements that are necessary to make a working embodiment of the invention. Under § 112, first paragraph, the specification must be enabling. Under § 112, second paragraph, the claim must claim “the subject matter which the Applicant regards as his invention.” Nothing in the statute requires Applicant to claim all elements that in addition to those that state the invention make up a working embodiment. § 112, second paragraph, requires only that the claims must have a clear and definite meaning when construed in light of the specification. The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the claim, § 112 demands no more. *Miles Laboratories Inc. v. Shandon Inc.*, 27 USPQ2d 1123 (Fed. Cir.1993).

Applicant submits that the above also holds true with respect to claim 14.

The burden is on the Examiner to demonstrate that the claims do not comply with 35 U.S.C. § 112. In the Office Action, no attempt is made to justify the erroneous conclusion that essential elements are allegedly missing from claims 6 and 14. In fact, a review of the specification of the subject Application makes clear that the claims contain the essential elements that form the invention. For example, nowhere in the Summary of the Invention or otherwise in the Application has Applicant stated that the fingers, searcher, or multiple rake combiners in each processing block are essential elements for his invention. Indeed they are not. If the

Examiner intends to repeat this rejection, Applicants request that the Examiner point to the specific portions of the record that support the Examiner's conclusion that Applicant has stated that the omitted elements are "essential" to the invention.

Therefore, in view of the above, Applicant respectfully requests that the §112 rejection of claims 6 and 14 be reconsidered and withdrawn.

### **§103(a) Rejection**

Claims 6 and 14 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Hayashi and Hanaoka. Applicant respectfully traverses the rejection.

The Examiner refers to Figure 23 of Hayashi as teaching an apparatus for processing reception data including a decoder 308 and rake combiners 2006 and 2013 and memories 2017 and 2019 between the rake combiners and the decoder. The Examiner also asserts that the decoder reads out signals from the memories based on a high priority (best line condition). However, Hayashi fails to teach or suggest a decoder reading out received signals according to a high priority based on a service type of the signals. Rather, as discussed at col. 10, lines 53-63, the base station selects a signal from a memory corresponding to an antenna having the best line condition. Similarly, Hanaoka fails to teach or suggest a decoder reading out received signals from memory according to a high priority based on a service type of the signals.

Therefore, Applicant submits that claims 6 and 14 are patentable over the cited combination of references and respectfully requests that the §103(a) rejection of claims 6 and 14 be reconsidered and withdrawn.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/918,497

Q65530

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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